REMARKS

I. Introduction

With the cancellation herein of previously withdrawn claims 21 to 33, claims 1 to 20 are now pending and being considered in the present application. Claim 11 has been amended herein for clarity and claims 3 and 13 have been amended herein to be in independent form (strikeouts indicating deleted text and underlining indicating added text). No new matter has been added.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Interview Summary

Applicant thanks the Examiner for the courtesies extended during the telephone interview of July 22, 2008 between Examiner Chavis and Applicant's representative, Aaron Grunberger (Reg. No. 59,210).

The following is a Statement of Substance of Interview of the telephone interview of July 22, 2008.

During the course of the telephone interview, Examiner Chavis clarified that claim 11 stands rejected under 35 U.S.C. § 101 as assertedly directed to non-statutory subject matter. Examiner Chavis stated that the rejection would be overcome by amending the claim to clarify that the claimed apparatus includes a processor.

With respect to the prior art rejections, Applicant's representative noted that, even if a feature relied upon by Applicant for distinguishing a claim is included only in the preamble of the claim, the feature must be considered just as any other claim limitation.

Applicant further clarified that the intention of the argument presented in Applicant's Response dated February 19, 2008 that "[n]owhere does the George reference disclose a method of optimizing the dependencies determined based on the JDBC database" was not that a prior art reference must disclose optimizing dependencies determined based on a JDBC database in order for the prior art reference to be said to disclose the features of the claims. Rather, a prior art reference must disclose optimizing dependencies. It so happens to be that the section, column 1, line 57 to column 2, line 6, of U.S. Patent No. 7,143,108 ("the George reference") relied upon by the Examiner as disclosing the feature of automatically detecting dependencies among a set of objects refers to determining a dependency structure based on JDBC database metadata or the like. *See* the George reference, e.g., column 5. Therefore, if any optimization of dependencies would be disclosed in the George reference, it

would have to be those dependencies relied upon as disclosing the feature of "automatically detecting dependencies," *i.e.*, the dependency structure of column 1, line 57 to column 2, line 6 of the George reference, which happens to be determined in the George reference based on JDBC database metadata or the like. Therefore, that the claims do not recite JDBC database metadata is irrelevant.

The general result or outcome of the telephone interview is that agreement was reached regarding the rejection of claim 11 under 35 U.S.C. § 101 that the claim would overcome the rejection if amended as herein and regarding the prior art rejections that the Examiner would reconsider Applicant's arguments in view of the requirement to consider the preamble if relied upon by Applicant and in view of the clarification of the argument regarding the dependency structure determined in the George reference based on JDBC database metadata.

III. Rejection of Claims 8 and 18[1] Under 35 U.S.C. § 112

Claims 8 and 18 were rejected under 35 U.S.C. § 112, ¶ 2 as assertedly indefinite.

Claim 8 depends from claim 1, which recites automatically detecting dependencies. Claim 8 further recites an additional step of manually detecting dependencies and adding the manually detected dependencies to said dependency list. Thus, claim 8 requires both the automatic detection and the manual detection.

Claim 18 depends from claim 11, which recites means for automatically detecting dependencies. Claim 18 further recites additional means for manually detecting dependencies and means for adding said manually detected dependencies to said dependency list. Thus, claim 18 requires both means for automatic detection and means for manual detection.

The Office Action asserts that the claimed features are unclear because it is assertedly not clear why information that has previously been automatically detected has to also be manually detected. However, claims recite the invention. Their purpose is not to explain how the invention works or why steps are performed. That role is left to the specification. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983). Thus, the claims need not at all recite why the various steps are included. Therefore,

[1] The Office Action indicates that claim 20 is also included in this rejection, but substantively addresses only claims 8 and 18. The reference to claim 20 is therefore assumed to be an oversight.

that the claims themselves do not explain the benefit of the implementation of both the automatic and manual detections does not render the claims indefinite.

Notwithstanding the above, it is noted that the specification explains that there may be discrepancies between a set of dependencies that may be automatically detected and a set which a user manually discerns. Therefore, the manual detection is not merely a duplicative process. For example, the specification at page 7, lines 5 to 8 notes that a dependency checker does not ensure detection of all required dependencies. Similarly, page 13, lines 7 to 15 notes that a user may provide additional dependencies over and above those automatically detected. Thus, one skilled in the art would understand the purpose of performance of both the automatic and manual detections. That is, the system may further provide for presenting output via which a user may manually detect dependencies different than those already automatically detected and may further provide for receipt of input via which to add the manually detected dependencies to a dependency list, e.g., to update one automatically generated.

Accordingly, the claims are believed to be clear, give rise to no ambiguity, and therefore definite.

Withdrawal of the present rejection under 35 U.S.C. § 112, ¶ 2 of claims 8, 18, and 20 is therefore respectfully requested.

IV. Claim 11

During the interview of July 22, 2008, the Examiner clarified that claim 11 is rejected under 35 U.S.C. § 101. While Applicant does not agree with the merits of this rejection, to facilitate matters, claim 11 has been amended herein without prejudice to obviate the present rejection. Withdrawal of the present rejection is therefore respectfully requested.

V. Objection to the Specification

The Specification has been amended herein to remove browser-executable code, thus rendering the present objection moot.

VI. Rejection of Claims 1, 2, 8 to 12, and 18 to 20 Under 35 U.S.C. § 103(a)

Claims 1, 2, 8 to 12, and 18 to 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the George reference and U.S. Patent No. 6,820,101 ("the Wallman reference"). It is respectfully submitted that the combination of the George and Wallman references does not render unpatentable any of claims 1, 2, 8 to 12, and 18 to 20, and the present rejection should be withdrawn, at least for the following reasons.

Independent claim 1 relates to a method for optimizing dependencies for a set of objects. Neither of the cited references relates to optimizing dependencies. As explained in Applicant's Response dated February 19, 2008, the George reference relates to a method of deleting records (also referred to by the George reference as objects). For deletion of records, the method of the George reference determines dependencies between tables of a database based on JDBC database metadata. According to the table dependencies, the method of the George reference determines whether deletion of a record of one of the tables requires deletion of a corresponding record in a table linked to the table that included the record being deleted. *See, e.g.*, the George reference, at column 8, line 24 to column 9, line 28. Nowhere does the George reference disclose a method of optimizing the dependencies determined based on the JDBC database metadata, and therefore does not disclose any of the features recited in claim 1.

In response to the above argument, the Final Office Action notes that "optimizing dependencies" is mentioned only the preamble of the present claims and further notes that the features of JDBC database metadata is not recited in the present claims.

As to the argument that optimizing dependencies is mentioned only in the preamble, it is noted that "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09, 62 U.S.P.Q.2d 1781, 1785 (Fed. Cir. 2002); *M.P.E.P.* § 2111.02.

As to the argument regarding the features of JDBC database metadata, it is apparent that clarification of Applicant's previously presented argument is in order. As explained during the course of the interview of July 22, 2008, Applicant does not intend to argue that the George reference does not disclose optimizing dependencies determined based on JDBC database metadata. Instead, Applicant argues that the George reference does not disclose or suggest optimizing dependencies at all. In this regard, the only reference in the George reference to dependencies are those determined between tables of a database based on JDBC database metadata. Therefore, if the George reference would at all refer to

optimization of dependencies, it would have to be optimization of those dependencies determined in the George reference between the tables of the database based on JDBC database metadata, since the George reference refers to no other dependencies. However, the George reference does not refer to optimization of those dependencies. Indeed, the George reference does not refer to optimization of dependencies of any kind.

The Final Office Action, however, clarifies the intention to rely on the records themselves as disclosing dependencies since some records are child records of other records, rendering them dependents upon those other records and further clarifies the intention to rely on the deletion of records itself as assertedly disclosing the steps performed in a method of optimization of dependencies. As an initial matter, the application of the George reference to the features of the claims by relying on the records as disclosing the dependencies requires a loose use of the term "dependencies" of the claims in conflicting, and thus clearly incorrect, ways. For example, the Office Action states that the George reference discloses a method for optimizing dependencies for a set of objects "by determining dependencies between objects." Final Office Action, page 3. A dependency therefore cannot be a record, because while a record may be a child of, and therefore depend upon, a parent record, the record itself is not a dependency between objects of a relational database. Similarly, the Office Action refers to column 1, line 57 to column 2, line 6 as assertedly disclosing the feature of automatically detecting dependencies among a set of objects. Final Office Action, page 4. The cited section refers to determining a dependency structure of a relational database using database metadata. A dependency therefore cannot be a record, because while a record may be a child of and therefore depend upon a parent record, the record itself is not what is "determined" at column 1, line 57 to column 2, line 6. Further, as noted above, the record is not a dependency among a set of objects. It is therefore clear that the Office Action cannot rely on a record, which happens to be a child of a parent record and therefore depends upon the parent record, as disclosing the dependencies of the claim. Indeed, a dependency is not an object itself, but rather the way in which objects relate to each other.

Thus, as explained above, if the George reference would at all refer to optimization of dependencies, it would have to be optimization of those dependencies determined in the George reference between the tables of the database based on JDBC database metadata. However, as also noted above, the George reference does not refer to optimization of those dependencies.

The Wallman reference refers to a method of freeing up memory blocks that were used for instantiated objects that are no longer used. The method includes determining

whether an object is referenced. If it is determined that an object is no longer referenced, then the memory block used for the instantiated object is freed up. This method has nothing to do with optimizing dependencies. Indeed, nowhere does the Wallman reference disclose a method for optimizing dependencies, and therefore does not disclose any of the features recited in claim 1.

Further, claim 1 recites *removing dependencies from said dependency list for any object that does not also have at least one file dependency*. The Office Action asserts that this feature is inherently disclosed in the George reference since the George reference refers to deleting child objects when parent objects are deleted. However, the deletion of the child objects in the George reference has nothing to do with deleting dependencies from a list. First, as explained above, the deletion of a child record itself cannot be relied upon as disclosing removing a dependency because, as explained above, such an interpretation requires conflicting uses of the term "dependency" in the claims. Second, the deletion of a child record itself cannot be relied upon as disclosing removing dependencies as provided for in the context of claim 1, because deletion of the record does not disclose removing a dependency *from a dependency list*, as recited in claim 1.

As regards the determined dependency structure referred to in the George reference, the dependencies of the George reference are not between records, and thus not between the parent and child objects discussed in the George reference. Instead, the dependencies are between tables. The tables for which the dependencies are generated include many records. When a record of one of the tables is deleted, the dependencies are used to determine whether any records of another of the tables are also to be deleted. Even with deletion of the parent and child records, there is no reason to delete the table dependencies. Indeed, the dependencies between the tables are not indicated to be deleted and are not inherently deleted.

The Office Action further asserts that it would have been obvious to modify the George reference to include this feature in view of the Wallman reference since the Wallman reference discloses the freeing up of memory blocks when an object is no longer referenced. As set forth above, the Wallman reference is unrelated to optimizing dependencies, and the deletion step in the Walman reference does not disclose removing dependencies from a dependency list. Since neither of the George and Wallman references discloses removing dependencies from a dependency list, a combination of the George and Wallman references to disclose this feature necessarily requires an improper hindsight reconstruction based on Applicant's disclosure.

Specifically, even if the method of the George reference is modified to include the features of the Wallman reference, the resulting method would merely include the step of freeing up a blocks of memory that previously included parent and child records that are deleted in the George reference in accordance with the dependencies generated based on the JDBC database metadata. One skilled in the art would not further modify the method of the George reference to include modification of the generated dependencies themselves in view of the Wallman reference, since neither of the references relates to modification or optimization of dependencies and neither of the references discloses removing dependencies from a dependency list.

Furthermore, deletion of a parent record and a child record from tables does not change dependencies between the tables from which the records were deleted. Thus, one would not modify the table dependencies of the George reference in response to the deletion of the records.

For all of the foregoing reasons, the combination of the George and Wallman references does not disclose or suggest all of the features of claim 1, so that the combination of the George and Wallman references does not render unpatentable claim 1 or any of its dependent claims 2 and 8 to 10.

Independent claim 11 includes subject matter analogous to that of claim 1, so that claim 11 and its dependent claims 12 and 18 to 20, are allowable for at least essentially the same reasons as claim 1.

Withdrawal of this obviousness rejection is therefore respectfully requested.

VII. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 3 to 7 and 13 to 17 include allowable subject matter. In this regard, the Examiner will note that each of claims 3 (from which claims 4 to 7 depend) and 13 (from which claims 14 to 17 depend) has been rewritten in independent form and to include the subject matter of its respective base claim and any intervening claims. It is therefore respectfully submitted that claims 3 to 7 and 13 to 17 are in condition for immediate allowance.

VIII. Conclusion

In view of the foregoing, it is believed that any outstanding rejections of the claims should be withdrawn. Accordingly, it is respectfully submitted that all of the pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

Respectfully submitted,

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